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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/727,151	12/02/2003	David K. Swanson	03-0515 (US01)	5305

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EXAMINER	
ROANE, AARON F	
ART UNIT	**PAPER NUMBER**
3739	

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/07/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	10/727,151	SWANSON, DAVID K.	
	Examiner	Art Unit	
	Aaron Roane	3739	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *15 November 2006*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-20 and 28-41* is/are pending in the application.

4a) Of the above claim(s) *9,10,28-30,38 and 39* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-8, 11-20, 31-37, 40 and 41* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

Newly added claims 38 and 39 are directed to non elected species and are withdrawn by the examiner (see election/restriction requirement filed 6/14/2006).

Claim Objections

Claim 14 is objected to because of the following informalities: claim 14 recites "A surgical apparatus as claimed in claim 14," in line 1. These in formality was interpreted by the such that claim depends on claim 13. Appropriate correction is required.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-8, 11-20, 31-37, 40 and 41 are rejected under 35 U.S.C. 102(b) as being anticipated by Gadsby et al. (USPN 5,309,909).

Regarding claim 1, Gadsby et al. disclose a carrier (12) movable between an unstressed state (figure 3) and a deflected and stressed state (figure 4); a tissue stimulation element (collection of 18) supported on the carrier; and a tissue engagement device (22) associated with the carrier, configured to secure itself to tissue and secure the carrier to the tissue in the deflected and stressed state, see col. 3, line 53 through col. 6, line 29 and figures 1-4.

Regarding claim 2, Gadsby et al. disclose the claimed invention, see figures 3 and 4.

Regarding claims 3-5, Gadsby et al. further disclose the carrier includes a curved interior and first and second end portions, in the form of first and second tissue stimulation elements (the first end portion in the form of a tissue stimulation element is 18 located closest to 36 and the second end portion in the form of a tissue stimulation element is 18 located farthest from 36) and an interior portion and the carrier is configured such that the interior portion will be in spaced relation to the tissue when the end portions are in contact with the tissue and the carrier is in the unstressed state, see figures 1-4.

Regarding claims 6 and 7, Gadsby et al. disclose the claimed invention, see figures 3 and 4.

Regarding claim 8, Gadsby et al. disclose a carrier (12) movable between an unstressed state and a stressed state; a tissue stimulation element (collection of 18) supported on the

carrier; and first and second tissue piercing members (any first and second pointed tips of 18) associated with the carrier and configured to secure the carrier to tissue in the stressed state, see col. 3, line 53 through col. 6, line 29 and figures 1-4.

Regarding claims 11 and 12, Gadsby et al. disclose the claimed invention, see figures 3 and 4.

Regarding claim 13, Gadsby et al. disclose a tissue stimulation element (collection of 18); and means (22), associated with the tissue stimulation element, for securing the surgical apparatus to the tissue structure by engaging a single side of the tissue structure and pressing the stimulation element against the t-issue single side of the tissue structure, see col. 3, line 53 through col. 6, line 29 and figures 1-4.

Regarding claims 14 and 15, Gadsby et al. disclose at least a pair of electrodes (any two of 18), see figures 1-4.

Regarding claim 16, Gadsby et al. disclose a tissue stimulation element (12); and an anchor (tips of 18), associated with the tissue stimulation element, configured to secure the surgical apparatus to the tissue by piercing the tissue and press the stimulation element against the tissue, see col. 3, line 53 through col. 6, line 29 and figures 1-4.

Regarding claims 17 and 18, Gadsby et al. disclose at least a pair of electrodes (any two of 18), see figures 1-4.

Regarding claims 19 and 20, Gadsby et al. further disclose a flexible carrier (16) that is non-linear when in a relaxed state, see figures 3 and 4.

Regarding claims 31-33, Gadsby et al. disclose the claimed invention, see col. 3, line 53 through col. 6, line 29 and figures 1-4.

Regarding claim 34, Gadsby et al. disclose first and second tissue stimulation elements (the first end portion in the form of a tissue stimulation element is 18 located closest to 36 and the second end portion in the form of a tissue stimulation element is 18 located farthest from 36); a flexible carrier (12) movable between an unstressed state and a deflected and stressed state and including a first end portion that carries the first tissue stimulation element, a second end portion that carries the second tissue stimulation element, and a curved interior portion (16 located first and second end portions) located between the first and second end portions and configured such that the curved interior portion will be in spaced relation to the tissue surface when the end portions are in contact with the tissue surface and the carrier is in the unstressed state; and a tissue engagement device (tips of 18) carried by the curved interior portion of the carrier between the first and second tissue stimulation elements and configured to secure the

carrier to the tissue surface in the deflected and stressed state, see col. 3, line 53 through col. 6, line 29 and figures 1-4.

Regarding claims 35 and 36, Gadsby et al. disclose the claimed invention, see col. 3, line 53 through col. 6, line 29 and figures 1-4.

Regarding claim 37, Gadsby et al. disclose the claimed invention, see col. 3, line 53 through col. 6, line 29 and figures 1-4.

Regarding claim 40, Gadsby et al. disclose at least a pair of electrodes (any two of 18), see figures 1-4.

Regarding claim 41, Gadsby et al. disclose the claimed invention, see figures 1-4.

Response to Arguments

Applicant's arguments with respect to claims 1-8 and 11-21have been considered but are moot in view of the new ground(s) of rejection. New prior art (Gadsby et al. (USPN 5,309,909)) has been applied in order to reject the claims.

Additionally, Applicant has recited the subject matter: that the stimulation element is "too small to form a transmural myocardial lesion". The recitation is interpreted as intended use. A recitation of the intended use of the claimed invention must result in a structural difference

between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. Although operational characteristics of an apparatus may be apparent from the specification, we will not read such characteristics into the claims when they cannot be fairly connected to the structure recited in the claims. See In re Self, 671 F.2d 1344, 1348, 213 USPQ 1, 5 (CCPA 1982).

This action is FINAL.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Aaron Roane whose telephone number is (571) 272-4771. The examiner can normally be reached on Monday-Thursday 7AM-6PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Linda Dvorak can be reached on (571) 272-4764. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Aaron Roane A.R.
February 5, 2007

Roy D. Gibson
ROY D. GIBSON
PRIMARY EXAMINER